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EXAMINER

KALINOWSKI, ALEXANDER G

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2166

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35

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/650,834

Applicant(s)
Stephen C. Wren

Examiner
Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 9, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-87 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 29, 31 20) ☐ Other:

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DETAILED ACTION

1. Claims 30-87 are presented for examination. Applicant filed an amendment on 4/21/2000 canceling claims 10-19 and adding new claims 20-29. Applicant further filed a continued prosecution application including a preliminary amendment on 6/13/2001 canceling claims 20-29 and adding new claims 30-76. Applicant further filed an amendment on 11/9/2001 amending claims 30, 32-35, 41, 42, 44, 47, 48, 52, 53, 57, 59-61, 65, 68, 70, 71, and 74 and adding new claims 77-87. In light of Applicant's arguments and amendment to the claims, the Examiner withdraws the grounds of rejection of claims 39-41, 58, 61-63 and 70-76 based on 35 USC 112(1). In addition, for the same reasons, the Examiner withdraws the rejection of claims 30-43 and 59-69 based on 35 USC 112(2). However, the Examiner maintains the rejection of claims 30-76 based on 35 USC 112(1) (see Response to Arguments section for a detailed explanation). In light of the amendment to the independent claims, the Examiner withdraws the rejection of claims 30-77 based on 35 USC 103. However, due to Applicant's amendment to the claims, new grounds of rejection of claims 30-87 based on 35 USC 103 are established in the instant office action as set forth in detail below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 30-87 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe in any specificity how the system comprises a computerized central communications facility that is adapted to be coupled to a plurality of other computerized central communications facilities.

4. Claims 30-87 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe in any specificity how the system comprises a computerized central communications facility that is adapted to be coupled to a plurality of other computerized central communications facilities. No description was provided by Applicant as to how the claimed invention couples a plurality of central communications facilities together aside from the provision of an electronic phone book.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30-37, 39-43 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino, Pat. No. 5,231,571 in view of Dworkin, Pat. No. 4,992,940.

As to claim 30, D'Agostino discloses an apparatus to market and sell goods or services over an electronic network (see abstract) comprising:

a first computerized central communications facility adapted to be coupled to a plurality of other computerized central communications facilities, each of said first or other computerized central communications facilities having information relating to goods or services stored in a database, and each of said first or other computerized communications facilities having a processor programmed to (see Fig. 1, and col. 5, lines 64 - col. 6, line 35)

receive from a customer located at a computerized remote facility a request to at least one of search, browse and access in the database at the computerized central communications facility for information of interest (col. 6, line 50 - col. 7, line 50 and col. 11, lines 22-29).

D'Agostino does not explicitly disclose

enable said customer to at least one of search, browse and access said database for information of interest, direct a transmitter at said first or other computerized central communications facility to transmit said information of interest from the database at said computerized central communications facility to said computerized remote communications facility; and

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periodically update said database in said first or other computerized central communications facility.

However, Dworkin discloses enabling said customer to search said database for information of interest, direct a transmitter at said first or other computerized central communications facility to transmit said information of interest from the database at said computerized central communications facility to said computerized remote communications facility (col. 3, lines 60-69, col. 4, lines 35-61, and col. 5, lines 20). Dworkin further discloses periodically update said database in said computerized central communications facility (i.e. new product information)(col. 9, lines 36-47). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the features above as taught by Dworkin within D'Agostino for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 31, D'Agostino does not explicitly disclose the apparatus of claim 30, wherein said computerized central communications facility is further programmed to facilitate a transaction between said computerized central communications facility and said computerized remote communications facility.

However, Dworkin discloses computerized central communications facility is further programmed to facilitate a transaction between said computerized central communications facility and said computerized remote communications facility (col. 2, lines 33-41 and col. 8, lines 9-37).

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It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 30, wherein said computerized central communications facility is further programmed to facilitate a transaction between said computerized central communications facility and said computerized remote communications facility as taught by Dworkin within D'Agostino for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 32, D'Agostino does not explicitly disclose the apparatus of claim 30, wherein at least one of said computerized central communications facilities is further programmed to contact the customer and apprise said customer of goods and services offered or any special offerings.

However, Dworkin discloses wherein at least one of said computerized central communications facilities is further programmed to contact the customer and apprise said customer of goods and services offered or any special offerings (col. 9, lines 36-47). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 30, wherein at least one of said computerized central communications facilities is further programmed to contact the customer and apprise said customer of goods and services offered or any special offerings as taught by Dworkin within D'Agostino for the motivation of alerting the customer of any new products offered (col. 9, lines 36-47).

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As to claim 33, D'Agostino discloses the apparatus of claim 30, wherein said computerized central communications facility and each of said other computerized central communications facilities are associated with competing providers of goods and services (see Fig. 1 and col. 6, lines 30-40).

As to claim 34, D'Agostino discloses the apparatus of claim 30, wherein at least one of said computerized central communications facility and said other computerized central communications facilities further include an audio communication device for communication with said computerized remote communications facility (col. 6, lines 17-23).

As to claim 35, D'Agostino discloses the apparatus of claim 30, wherein said computerized central communications facility and at least one of said other computerized central communications facilities is further adapted to provide information relating to goods and services in the form of an audio or video presentation (col. 6, lines 17-23).

As to claim 36, D'Agostino does not explicitly disclose the apparatus of claim 35, wherein said apparatus further comprises means for recording a presentation stopping point for future reference .

However, the Examiner takes official notice that it was old and well known in the computer sales presentation arts to provide a stopping point in a user's presentation (i.e. saving a

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file which represents a potential transaction). This allows a user to resume a transaction at a later date without having to resubmit previously entered information. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for recording a stopping point in the customer's last on-line presentation in case contact is resumed within D'Agostino and Dworkin for the motivation of allowing a customer to resume a transaction at a later date without having to resubmit previously entered information.

As to claim 37, D'Agostino discloses the apparatus of claim 30, wherein said processor is further programmed to compile a customer profile based on the customer's search of the database (col. 15, line 59 - col. 16, line 8).

As to claim 39, D'Agostino disclose the apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to present information of interest to said customer (col. 6, lines 17-29).

As to claim 40, D'Agostino discloses the apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to enable the customer to communicate with said central communications facility (col. 6, lines 17-29).

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As to claim 41, D'Agostino does not explicitly disclose the apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to enable said customer to conduct a transaction using the information provided by said computerized central communications facility relating to goods and services.

However Dworkin discloses processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to enable said customer to conduct a transaction using the information provided by said computerized central communications facility relating to goods and services (Fig. 1, and col. 2, lines 20-41). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the features above as taught by Dworkin within D'Agostino for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 42, D'Agostino discloses the apparatus of claim 30, wherein said processor is further programmed to provide an interactive presentation relating to goods and services (col. 6, lines 17-23 and lines 58-63).

As to claim 43, D'Agostino does not explicitly disclose the apparatus of claim 42, wherein said interactive presentation includes an audio presentation in the form of a computerized voice.

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However, the Examiner takes official notice that it well known in the electronic sales presentation arts to have an interactive presentation includes an audio presentation in the form of a computerized voice. The purpose of computerized voice was to have a customer friendly sales presentation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 42, wherein said interactive presentation includes an audio presentation in the form of a computerized voice within D'Agostino for the motivation stated above.

As to claim 77, D'Agostino discloses the apparatus of claim 30, wherein said computerized central computerized is further programmed to provide said customer with live assistance upon request (col. 6, lines 50-53).

7. Claims are 44-55, 57-65, 67-76 and 78-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino in view of Dworkin and Randle et al, Pat. No. 5,899,982 (hereinafter Randle).

As to claim 44, D'Agostino discloses an apparatus for marketing at least one of goods and services (see abstract):

a first central communications facility to provide first information relating to goods or services to a customer at a remote facility (see Fig. 1, and col. 5, lines 64 - col. 6, line 35);

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a second central communication facility to provide information relating a second set of information to goods and services (see Fig. 1, and col. 5, lines 64 - col. 6, line 35) ;

D'Agostino does not explicitly disclose

providing access to a database of information relating to goods and services.

However, Dworkin discloses providing access to a database of information relating to goods and services (col. 3, lines 60-69, col. 4, lines 35-61, and col. 5, lines 20).. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the features above as taught by Dworkin within D'Agostino for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

D'Agostino and Dworkin do not explicitly disclose

said first communications facility adapted to direct said customer to a second communications facility.

However, Randle discloses said first communications facility adapted to direct said customer to a second communications facility (i.e. bank platform enables access by a customer at a remote location to conventional information, products and services ... and to other providers of financial and non-financial information, products and services ... accomplished via access gateway 40 of the central information processor)(See Fig 1 and col. 3, lines 22-55). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said first communications facility adapted to direct said customer to a second communications facility as disclosed by Randle within D'Agostino for the motivation of managing the flow of information to

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a customer thereby maintaining a relationship with the customer while becoming the gateway for providing access to other products and services offered by other providers by becoming the gateway (col. 2, lines 13-26).

D'Agostino and Dworkin do not explicitly disclose a communication device to enable each of said first communication facility and said second communications facility to communicate with said remote facility, said communication including transmitting said first or second set of information from said first or second central communications facilities to said remote facility.

However, Randle discloses a communication device to enable each of said first communication facility and said second communications facility to communicate with said remote facility, said communication including transmitting said first or second set of information from said first or second central communications facilities to said remote facility (i.e. bank platform enables access by a customer at a remote location to conventional information, products and services ... and to other providers of financial and non-financial information, products and services ... accomplished via access gateway 40 of the central information processor)(See Fig 1 and col. 3, lines 22-55). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a communication device to enable each of said first communication facility and said second communications facility to communicate with said remote facility, said communication including transmitting said first or second set of information from said first or second central communications facilities to said remote facility as disclosed by Randle

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within D'Agostino for the motivation of managing the flow of information to a customer thereby maintaining a relationship with the customer while becoming the gateway for providing access to other products and services offered by other providers by becoming the gateway (col. 2, lines 13-26).

As to claim 45, the claim is substantially similar to claim 31 and is rejected on the same basis.

As to claim 46, the claim is substantially similar to claim 30 and is rejected on the same basis.

As to claim 47, D'Agostino does not explicitly disclose the apparatus of claim 44, wherein said central communications facility or at least one of the other central communications facilities further provides a directory of providers of goods and services.

However, Dworkin discloses wherein said central communications facility further or at least one of the other central communications facilities further provides a directory of providers of goods and services (see Fig. 3, and col. 3, lines 65-69). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 44, wherein said central communications facility further or at least one of the other central communications facilities provides a directory of providers of goods and services as taught by

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Dworkin within D'Agostino for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 48, the claim is substantially similar to claim 35 and is rejected on the same basis.

As to claim 49, the claim is substantially similar to claim 43 and is rejected on the same basis.

As to claim 50, the claim is substantially similar to claim 42 and is rejected on the same basis.

As to claim 51, the claim is substantially similar to claim 36 and is rejected on the same basis.

As to claim 52, D'Agostino discloses the apparatus of claim 44, wherein said goods and services include financial services (col. 6, lines 30-36).

As to claim 53, D'Agostino discloses the apparatus of claim 44, wherein said goods and services include auctioning services (col. 6, lines 30-36).

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As to claim 54, D'Agostino does not explicitly disclose the apparatus of claim 44, further comprising a software application for assisting the central communications facility to download a contract to the computerized remote location.

However, Dworkin discloses further comprising a software application for assisting the central communications facility to download a contract to the computerized remote location (col. 8, lines 10-24). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 44, wherein said central communications facility further or at least one of the other central communications facilities further provides a directory of providers of goods and services as taught by Dworkin within D'Agostino for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 55, the claim is similar in scope to claim 37 and is rejected on the same basis.

As to claim 57, the claim is similar in scope to claim 39 and is rejected on the same basis.

As to claim 58, the claim is similar in scope to claim 40 and is rejected on the same basis.

As to claim 59, the claim is substantially similar to claim 44 and is rejected on the same basis.

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As to claim 60, D'Agostino discloses the method of claim 59, further comprising establishing communication with a third database containing information relating to goods and services (see Fig. 1).

As to claims 61-65, the claims are similar in scope to claims 39-41 and are rejected on the same basis.

As to claim 67, the claim is similar in scope to claim 42 and is rejected on the same basis.

As to claim 68, the claim is similar in scope to claim 35 and is rejected on the same basis.

As to claim 69, the claim is similar in scope to claim 36 and is rejected on the same basis.

As to claim 70, D'Agostino discloses an apparatus for marketing goods and services (see abstract), comprising:

a central communications facility to provide information relating to goods and services to a customer at a computerized remote facility, said central communications facility (see Fig. 1 and col. 5, lines 64 - col. 6, line 35);

a first communication device associated with said central communications facility

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for providing live communication between the central communications facility and said computerized remote facility (col. 6, lines 17-27);

a second communication device at said central communications facility associated with a second communication path for providing a second communication between said central communications facility and said computerized remote facility (col. 6, lines 17-27); and D'Agostino does not explicitly disclose

a database of information relating to goods and services accessible by said customer at said remote facility.

However, Dworkin discloses a database of information relating to goods and services accessible by said customer at said remote facility (col. 3, lines 60-69, col. 4, lines 35-61, and col. 5, lines 20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the features above as taught by Dworkin within D'Agostino in order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

D'Agostino does not explicitly disclose

said central communications facility adapted to direct said customer to at least one other central communications facility providing information relating to goods and services.

However, Randle discloses said central communications facility adapted to direct said customer to at least one other central communications facility providing information relating to goods and services (i.e. bank platform enables access by a customer at a remote location to

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conventional information, products and services ... and to other providers of financial and non-financial information, products and services ... accomplished via access gateway 40 of the central information processor)(See Fig 1 and col. 3, lines 22-55). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said central communications facility adapted to direct said customer to at least one other central communications facility providing information relating to goods and services as disclosed by Randle within D'Agostino for the motivation of managing the flow of information to a customer thereby maintaining a relationship with the customer while becoming the gateway for providing access to to other products and services offered by other providers by becoming the gateway (col. 2, lines 13-26).

As to claim 71, the claim is similar in scope to claim 47 and is rejected on the same basis.

As to claim 72, the claim is similar in scope to claim 42 and is rejected on the same basis.

As to claims 73-76, the claims are similar in scope to claims 39-41 and are rejected on the same basis.

As to claim 78, the claim is similar in scope to claim 77 and is rejected on the same basis.

As to claim 79, D'Agostino does not explicitly disclose

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the apparatus of claim 44 wherein said first communications facility further enables said customer to browse said first set of information relating to goods and service.

However, Dworkin discloses the apparatus of claim 44 wherein said first communications facility further enables said customer to browse said first set of information relating to goods and service (fig. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said first communications facility further enables said customer to browse said first set of information relating to goods and service as disclosed in Dworkin within D'Agostino for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 80, D'Agostino does not explicitly disclose wherein the apparatus of claim 44 wherein said second communications facility further enables said customer to browse said second set of information relating to goods and service.

However, Dworkin discloses a communications facility further enables said customer to browse a set of information relating to goods and service (fig. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said second communications facility further enables said customer to browse said second set of information relating to goods and service as disclosed in Dworkin within D'Agostino and Randle for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

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As to claim 81, D'Agostino does not explicitly disclose the method of claim 59, further comprising enabling the remote facility to search said first database or said second database.

However, Dworkin discloses further comprising enabling the remote facility to search said first database or said second database (fig. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include enabling the remote facility to search said first database or said second database as disclosed in Dworkin within D'Agostino and Randle for the motivation of providing a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claims 82-87, the claims are similar in scope to claims 70-76 and 78-81 and are rejected on the same basis.

8. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino and Dworkin as applied to claim 37 above, and further in view of Filepp et al., Pat. No. 5,347,632.

As to claim 38, D'Agostino and Dworkin do not explicitly disclose the apparatus of claim 37, wherein said processor is further programmed to provide targeted advertising based on said customer profile.

However, Filepp discloses a computerized system that records customer preferences (i.e. responses) with respect to products offered for sale or purchased by the customer(col. 2, lines 46-50 and col. 93, lines, lines 28-43). The recorded customer responses represent the customer

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profile information, detailing user activity for the customer using the computerized system (col. 5, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 37, wherein said processor is further programmed to provide targeted advertising based on said customer profile as disclosed by Filepp within D'Agostino in order to target advertisements or product offers (i.e. information) to specific customers based on consumer marketing strategies developed from the customer profile information (col. 93, lines 39-43).

9. Claim 56, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino, Dworkin and Randle as applied to claims 55 and 65 above, and further in view of Filepp.

As to claims 56 and 66, the claims are similar in scope to claim 38 and are rejected on the same basis.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 30-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,055,514 in view of Dworkin, D'Agostino, Randle and Filepp.

As to claim 30, the '514 patent discloses an apparatus to market and sell goods and/or services over an electronic network (see claim 2) comprising:

a computerized central communications facility adapted to be coupled to a plurality of other computerized central communications facilities and to a network, each of said computerized central communications facilities having information relating to goods and/or services stored in a database, and each of said computerized communications facilities having a processor programmed to (see claim 1):

receive from a customer located at a computerized remote facility a request to search in the database at the computerized central communications facility for information of interest (claim 1);

provide said customer with live assistance upon request (claim 2);

enable said customer to search said database for information of interest, direct a transmitter at said computerized central communications facility to transmit said information of

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interest from the database at said computerized central communications facility to said computerized remote communications facility (claim 1); and

The '514 patent does not explicitly disclose

periodically update said database in said computerized central communications facility.

However, Dworkin discloses periodically update said database in said computerized central communications facility (i.e. new product information)(col. 9, lines 36-47). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the features above as taught by Dworkin within the '514 patent in order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

Response to Arguments

12. With respect to Applicant's argument directed to the rejection of claims 30-76 based on 35 USC 112(1) that the claims do not disclose "how the system comprises a central communication facility coupled to a plurality of other computerized central computerized facilities", the Applicant argues that the specification reasonably conveys to one of ordinary skill in the art that the inventor had possession of the invention at the time of filing. The Examiner disagrees. As a preliminary note, the Examiner assumes that support for the aforementioned feature is found only in the instant application since Applicant's arguments are directed to the instant application only and therefore, the Applicant relies on the specification in the instant application for support of this feature. First, Applicant refers to Figure 1 for support. The Figure

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discloses a central communication facility 12 that is connected to remote communication facility 14 through a phone connection between phones 34 and 20 and modems 30 and 16. No other connection from central communication facility 12 appears in the figure. Therefore, central communication facility is coupled to remote communication facility 14 only. A further connection is shown from remote communication facility 14 to central facility 2, unit 12 through central facility #n unit 12. However, the Examiner disagrees that the central communication facility 2 is connected to both central facility n and remote facility 14. The connection shown between central facility 2 and central facility n shows that one or more central facilities can be included in the connection to remote facility 14. Neither the drawing or the specifications provides a description that would lead one to assume that central facility 2 is coupled to central facility n. Therefore, the drawing supports a remote facility coupled to a plurality of central communications facilities but not a central communications facility coupled to a plurality of other communications facilities. Furthermore, no mention is made in the specification as to how the central communications facilities are coupled to each other. The specification fails to disclose how the invention couples central communications facilities to each other. Instead, as disclosed and supported in the specification, it is the remote facility that is coupled to a plurality of central communications facilities (see page 20, lines 2-11). Based on the specification and drawing, the connection between the remote communication facilities and central communications facilities can be either via modem and/or telephone. With respect to Applicant's arguments directed to the feature of "how a customer at a remote facility can request to search a database at the computerized central

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communications facility”, the Examiner agrees with Applicant’s arguments and withdraws that portion of the rejection of claims 30-76 based on 35 USC 112(1). However, the specification fails to disclose the claimed “first centralized communications facilities coupled to a plurality of other computerized communications facilities and therefore, Applicant’s arguments directed to this feature is non-persuasive . The Examiner maintains the rejection of claims 30-76 based on 35 USC 112(1). In addition, based on Applicant’s arguments that the instant application provides adequate support for disclosing a central communications facility coupled to a plurality of other central communications facilities, new grounds of rejection of claims 30-87 based on 35 USC 112(1) are set forth in that the instant application does not provide an enabling disclosure. The new grounds of rejection are set forth in detail above.

13. With respect to 35 USC 112(1) rejection of claims 39-41, 58, 61-63 and 73-76, based on Applicant’s arguments and cited support in the instant application directed to downloading software from the central communications facility to the remote facility, the Examiner withdraws the rejection.

14. With respect to the 35 USC 112(1) rejection of claims 70-76, in light of Applicant’s amendment to claim 70 deleting the recitation of a digital communication device, the Examiner withdraws the rejection.

15. With respect to the 35 USC 112(2) rejection of claims 30-43 and 59-69, in light of Applicant’s amendment to the claims, the Examiner withdraws the rejection.

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16. With respect to Applicant's arguments directed to the rejection of claims 30-37, 39-55, 57-65 and 67-76 based on 35 USC 103, Applicant argues that the D'Agostino does not disclose a plurality of central communications facilities. The Examiner disagrees. As argued by Applicant, Fig. 1 of D'Agostino discloses a plurality of customer terminals 14A-14X linked to representative terminals 12A-12X. Applicant argues that even if the representative terminals are considered to be central communications facilities, they are not connected to each other. However, as discussed in the rejection of claims 30-76 based on 35 USC 112(1), Applicant's specification and drawings fail to disclose this feature. D'Agostino explicitly discloses that the representative terminals may be located at different central locations (see col. 5, line 66- col. 6, line 1). Therefore, D'Agostino discloses a plurality of central communications facilities. Furthermore, with respect to Dworkin, Applicant points out that the Dworkin reference in the sentence bridging col. 1 and col. 2. Accesses a database that could be located elsewhere besides CPU 1. Therefore, Dworkin at least suggests at least one other central communications facility besides CPU 1. Therefore, Applicant's argument is nonpersuasive.

Applicant further argues that the D'Agostino references and Dworkin references cannot be combined in that Dworkin would change the principle of operation of D'Agostino unsuited for its intended purpose. The Examiner disagrees. Dworkin is not merely an automated system as characterized by Applicant or a self service system. Dworkin discloses means for a customer to communicate with the management of the system to register complaints, or to request help in using the system (col. 2, lines 42-49 and col. 10 and Fig. 3). Dworkin at least acknowledges that a

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user might require some interaction with system management when using the system. Therefore, Applicant's arguments directed to the combination of D'Agostino and Dworkin are nonpersuasive.

17. With respect to the rejection of claims 38, 56 and 66, Applicant's argues that each of claims 38, 56, and 66 depend from an independent claim that has been previously discussed and that claims 38, 56, and 66 are patentable for the same reasons. However, since the Examiner found Applicant's arguments directed to the independent claims to be nonpersuasive, the Examiner finds Applicant's arguments to claims 38, 56 and 66 to be nonpersuasive.

18. Applicant filed a substitute oath. Therefore, the Examiner withdraws the objection to the oath.

19. With respect to the Information Disclosure Statement filed by Applicant on 8/9/2001, the references cited on the Information Disclosure Statement have already been considered during the course of prosecution of the instant application. Therefore, since the references were already considered by the Examiner, the Examiner crossed out the listed references on the Information Disclosure Statement.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 8:30 AM to 6:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-0040.

Alexander Kalinowski

1/25/2002


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